

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOERG T. MERTINS

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Appeal No. 99-0031  
Application 08/639,737<sup>1</sup>

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ON BRIEF

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Before CALVERT, COHEN and CRAWFORD, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed April 29, 1996.

Appeal No. 99-0031  
Application 08/639,737

This is an appeal from the final rejection of claims 1, 2 and 4. Of the other claims remaining in the application, claim 3 has been indicated as being allowable if rewritten in independent form, and claims 6 to 8 have been allowed.

The claims on appeal are drawn to an attachment for a baseball type cap, and are reproduced in the appendix to appellant's brief.

The reference applied in the final rejection is:

Nieves-Rivera	5,493,734	Feb. 27, 1996
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Claims 1, 2 and 4 stand finally rejected under 35 U.S.C. § 102(e) as anticipated by Nieves-Rivera. Since appellant states on page 3 of the brief that the claims stand or fall together, we will decide the appeal on the basis of claim 1.

37 CFR § 1.192(c)(7).

The examiner sets forth the basis of the rejection on pages 2 and 3 of the final rejection (Paper No. 6) as:

Nieves-Rivera shows an attachment 10 comprised of securement means 12, 14, and 16, a connector portion having diverging side edges 17a, 17b, and neck shield 20a,

20b. Securement means 12, 14, and 16 could be secured to only the adjustment strap of a cap. This would be especially true if the cap was a relatively large cap with a relatively large adjustment strap and if the securement means 12, 14, and 16 were pushed together. . . .

. . . .

The securement means 12, 14, and 16 [of] Nieves-Rivera could clearly be secured to the adjustment strap of a relatively large size adjustment means if the securement means 12, 14, and 16 were pushed together. Further, the connector portion and shield 20a and 20b could [be] folded into and worn on the inside of a relatively large cap.

After fully considering the record in light of the arguments presented by appellant in the brief and reply brief, and by the examiner in the answer, we conclude that claim 1 is not anticipated by Nieves-Rivera.

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Although an element may be defined functionally, i.e., by what it does, it is anticipated if the prior art structure inherently possesses

the functionally defined limitations. Id., 128 F.3d at 1478, 44 USPQ2d at 1432.

In the present case, the preamble of claim 1 recites "[a]n attachment for a baseball type cap having a hemispheric opening and adjustment strap at the rear thereof and a bill in front, comprising, . . . ." Appellant, citing several cases, asserts that "the preamble is a limitation on the scope of the claim" (brief, page 9; reply brief, pages 1 and 2). Insofar as appellant may be arguing that claim 1 is drawn to the combination of a baseball type cap and an attachment, we agree with the examiner that it is not, since the preamble recites an attachment for a cap. However, the preamble limits the scope of the claim to the extent that where a limitation in the body of the claim refers back to structure recited in the preamble, the preamble structure referred to is incorporated into that limitation. For example, the recitation "securement means for securing said attachment only to the adjustment strap of said cap" is interpreted as "securement means for securing said

attachment only to the adjustment strap at the rear of a baseball type cap."

Nieves-Rivera does not disclose a baseball type cap, but rather discloses an attachment to the liner 32 of a helmet 36. This does not necessarily remove Nieves-Rivera as an anticipatory reference however, for it may still anticipate claim 1 if the structure disclosed would inherently be capable of performing the functions claimed. In re Schreiber, supra; In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967).

As for the specific limitations recited in claim 1, we agree with the examiner that Nieves-Rivera discloses the recited "securement means," since the securing devices 12, 14, 16 of the reference would be inherently capable of being secured to the

rear adjustment strap of a baseball type cap if they were pushed together, the claim language not excluding such an arrangement. Also, Nieves-Rivera discloses a connector portion and a

deployable neckshield portion, as claimed. However, we do not consider that the limitation "said connector portion being shaped such that when folded inside said cap, said connector portion fills said hemispheric opening to protect a user's forehead when worn in reverse style" is readable on the attachment (shield) 10 of Nieves-Rivera. The examiner contends that attachment 10 "could clearly be folded up and pivoted to the inside of [a baseball type] cap" (answer, page 5), but even assuming that to be correct, claim 1 also requires that when so folded, the connector portion protects a user's forehead "when worn." The attachment 10 of Nieves-Rivera is relatively large, extending down over the shoulders of the wearer and laterally over the cheeks (see Fig. 5). The reference does not disclose that attachment 10 may be folded inside the helmet 36, and given its size, we do not consider that even if it were attached to a relatively large baseball type cap, the cap could still be worn in a normal fashion if the attachment were folded inside it. In this regard, we agree with appellant that (brief, page 6; original emphasis):

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The structure of Nieves-Rivera's shield as disclosed in the drawings and described in the specification is a large billowy device generally incapable of being stuffed inside of a baseball cap and then worn as such. Even a larger size cap would not accommodate the shield of Nieves-Rivera and still be wearable on the head of a user.

Accordingly, since Nieves-Rivera does not disclose all the limitations of claim 1, the rejection of that claim under § 102(e), as well as of claims 2 and 4 grouped therewith, will not be sustained.

Conclusion

The examiner's decision to reject claims 1, 2 and 4 is reversed.

REVERSED

	IAN A. CALVERT	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	BOARD OF
PATENT		)	
	IRWIN CHARLES COHEN	)	APPEALS AND
	Administrative Patent Judge	)	INTERFER-
ENCES		)	
		)	

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MURRIEL E. CRAWFORD )  
Administrative Patent Judge )

IAC:psb

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